

line 24, change "Said" to --The--;
line 31, change "the" (last occurrence) to --a--;
Page 4, line 18, after "winding" insert --of--;
line 25, change "said" to --the--.

IN THE CLAIMS

Please amend the claims as follows:

Claim 4, line 2, change "ends" to --end portions--.

Claim 5, line 15, delete "whereby".

REMARKS

This amendment is submitted under the provisions of 37 C.F.R. §1.116.

The abstract has been amended so as to delete therefrom an objectionable phrase, i.e. --According to the invention-- etc.

The specification has been amended in order to improve the idiom and the grammar.

Applicant takes note of the fact that the Examiner has approved the drawing correction filed in the Patent and Trademark Office on 6/7/00.

Claims 3-5 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The Patent and Trademark Office relies upon the CCPA case of In re Mason, 114 USPQ 127, for the proposition that a "whereby" statement in a claim is functional and therefore is indefinite. This is a misinterpretation of the Mason decision. The "whereby" clause considered in the Mason decision was inoperative because it was purely functional and did not define any structure, and therefore could not serve to distinguish a product claim over the prior art. In fact, in Mason the court considered a second "whereby" statement in the claim at issue (claim 10), i.e. --whereby the corner portions of both webs are free--, but found that this difference over the applied prior art produced no new or unexpected result and therefore was not a patentable distinction. Thus, where a functional statement in a product claim helps to define the structure, such statement must be considered on its merits.

In claim 5 of this application, the "whereby" clause in fact helps to define the claimed structure, i.e. that the "cover (20) engages the coil base (10) and cooperates therewith to substantially completely enclose the coil windings." Although, as indicated above, Applicant does not agree with the Patent and Trademark Office holding that the term "whereby" per se is indefinite, nevertheless, in order to advance the prosecution of

this application, claim 5 has been amended above so as to delete this term which the Patent and Trademark Office finds to be objectionable.

As to the "112" rejection of claim 5, line 15 and claim 3, line 4 based upon the Patent and Trademark Office objection to the term "substantially", this term has been used in the claims of thousands of US patents, thereby evidencing the recognition by the Patent and Trademark Office of the validity of the use of this term in a claim. In fact, there is at least one CAFC decision upholding the definiteness and propriety of the use of the term "substantially" in a claim of US patent. Reconsideration and withdrawal of the "112" rejection of claims 3 and 5 is therefore respectfully requested. The Patent and Trademark Office objection to line 2 of claim 4 in paragraph 2 of the Final Rejection has been corrected in the above amendment of this claim.

Claims 3 and 5 were rejected under 35 U.S.C. §103(a) as being unpatentable over Witchger (USP 4,291,292) in view of Sugiura et al (USP 5,153,550).

Claim 5 is unobvious and therefore is patentable over the applied prior art of record, Witchger and Sugiura et al. First of all, this claim claims an electric ballast, whereas the Witchger patent is directed to an electric coil having means for the attachment of external supply lead wires to an electromagnetic coil

assembly. The Sugiura et al patent is for a coil assembly for an electromagnetic valve for use in a vehicular hydraulic control circuit. The reference patents are therefore in non-analogous arts to that of Applicant's invention, which places a higher burden of proof on the Patent and Trademark Office as to the issue of obviousness under 35 U.S.C. §103.

For example, why would one skilled in the art relating to electric ballasts for discharge lamps look to the Sugiura et al patent, which deals with a vehicle hydraulic control circuit, to solve a problem related to an electric ballast. The electrical characteristics of these two arts are so different that it would not suggest itself to the electric ballast engineer to look for solutions in the Sugiura et al patent. It is only by virtue of the hindsight provided by Applicant's present patent application that a motivation is presented for the Examiner to look into the Sugiura et al and Witchger prior art in order to reject the claims of this application.

Furthermore, it would not be obvious to combine these two references, much less in a manner that would result in the novel device claimed in claim 5, and the claims dependent thereon. For example, the Patent and Trademark Office argues that it would have been obvious to mount the external connection members of Witchger on the flange of the bobbin, as suggested by Sugiura et al, and to

use the modified coil assembly of Witchger in conjunction with the cover. But claim 5 calls for the separate cover to have "as a part thereof an external insulator (25) which engages said connection member (250) of the coil base". Since the cover 31 of Witchger is a thin strip made of a flexible material having some resilience, it could not support an external insulator such as the terminal housing 21 of the Sugiura et al cover member 20, much less in a manner so as to engage a connection member (unidentified in the Final Rejection) on a coil base (also not identified). The Sugiura et al coil assembly requires a rigid casing (cover) 20, which is not present in Witchger because the latter covers the windings of the coil base with a thin flexible resilient tape.

It therefore would not be obvious to modify the Witchger electric coil so that the cover 31 has an external connector part as defined in claim 5. The "103" rejection of claim 5 is invalid because the Final Rejection does not present the factual evidence required by 35 U.S.C. §103 in order to set out a prima facie case of obviousness.

As to dependent claim 3, this claim recites that the "cover has end portions which connect with each other" etc. In contrast, the ends 32 and 34 of the Witchger cover (31) do not connect with each other, as is evident from Figs. 10 and 12 of this reference, as well as column 3 thereof, and especially the last paragraph of

column 3 (and the first paragraph of column 4). Claim 3 is unobvious over the applied prior art since the Witchger patent does not provide the factual support to show the precise structure as defined in claim 3, wherefore the Final Rejection does not present a prima facie case of obviousness under 35 U.S.C. §103.

Claim 4 was rejected under 35 U.S.C. §103(a) as being unpatentable over Witchger in view of Sugiura et al and Leach et al (USP 4,363,014).

Since Leach et al does not cure any of the deficiencies noted above with respect to Witchger and Sugiura et al, any combination of these three references still would not result in the novel apparatus of dependent claim 4.

Furthermore, claim 4 specifies that the end portions of the cover connect with each other by one or more snap connections. In contrast, the end portions of the bobbin cover 14 in Leach et al do not connect with each other. The Final Rejection furthermore relies upon element 66 in Leach et al for disclosure of a snap connection means. But Leach et al refers to receptacle 66 (col. 3, line 28) into which the end 64 of a lead 20 is inserted. The receptacle 66 in Leach et al is clearly not a part of a snap connection means for interconnecting end portions of the cover member 14. In fact, the receptacle 66 of Leach et al is not even a part of the cover 14, much less an end portion thereof.

The Final Rejection clearly does not present sufficient factual evidence so as to set forth a prima facie case of obviousness as to claim 4 in the manner contemplated by 35 U.S.C. §103.

If the Patent and Trademark Office persists in its "103" rejection of the claims, then it should provide Applicant with a new Office Action that presents clear and convincing factual evidence to support the "103" rejection of the claims.

It is further noted that the Final Rejection is premature in that it presents new grounds of rejection that were not necessitated by Applicant's last amendment. More particularly, claim 5, which was substituted for claims 1 and 2, is essentially of the same scope as original claim 2 and therefore presented no new issues that would require further consideration and/or search by the Patent and Trademark Office.

Entry of this amendment is requested because it will place the application in condition for allowance or alternatively in better form for appeal. Entry also is proper because the amendments to the claims do not materially alter the scope thereof and therefore will require no further consideration and/or search by the Patent and Trademark Office.

The amendments were not made earlier because the Patent and Trademark Office objections to the claims were set forth with

particularity for the first time in the Final Rejection dated 8/29/00. Entry of the amendment also is proper because the Final Rejection is premature and incomplete as discussed above.

Reexamination and allowance of the application are respectfully requested.

Respectfully submitted,

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